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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/108,189 07/01/98 TANNER

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23660-00011

025243  
COLLIER, SHANNON, SCOTT, PLLC  
3050 K STREET, NW  
SUITE 400  
WASHINGTON DC 20007

QM12/0425

EXAMINER
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THISSELL, J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 04/25/01

16

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/108,189

Applicant(s)

Tanner et al.

Examiner

Jeremy Thissell

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 12, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 82, 85-87, and 96-103 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 82, 85-87, 96-100, 102, and 103 is/are rejected.

7) ☒ Claim(s) 101 is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 12 March 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/108,189 is acceptable and a CPA has been established. A NON-FINAL action on the CPA follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 82, 85-87, 96-98, 100, and 102 are rejected under 35 U.S.C. 102(e) as being anticipated by Hermann et al (US Pat No. 5,599,305).

Hermann teaches a introducer sheath having a positioning balloon 78 (see figure 6), and a sealing material 38 (see figure 8) in the sheath for surrounding and sealing the passage around surgical instruments introduced through the sheath. Hermann distinctly shows in figure 3 and teaches in col. 10, lines 4-9) that the sealing material does not readily form a passage when it is inserted in the

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housing (normal arrangement during use). Figure 4 is merely a drawing of the material if it were not inside the device. Hermann also teaches inflation lumens 80/82 (running along the instrument passageway) for the balloon(s). Lastly, Hermann teaches that the inner liner is formed of a polymer (col. 6, lines 21-24).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann et al (US 5,599,305).

Hermann teaches all the claimed subject matter but does not specifically teach that the outer surface of the device is made of silicon. However, Hermann does teach that the inner surface is coated with silicone in order to provide lubricity (col. 3, line 67). Since silicone is a well known lubricious material used to manufacture many different components of catheters, and since Hermann uses silicone to provide lubricity in the inner lumen, one would have found it obvious to choose silicone for the outer surface in order to provide a lubricious surface to facilitate insertion of the device.

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6. Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann '305 in view of Fettel et al (US 3,978,863).

Hermann teaches substantially all the claimed subject matter but does not teach that saline is used to inflate the balloon. However, the use of saline is universal in the art of catheters, and this point is supported by Fettel, who teaches that in "the most commonly used prior art catheter...a fluid, such as saline...is used to expand the balloon" (col. 1, lines 46 and 63-65). Saline is typically used instead of a gas when the device is used intravascularly in case the balloon breaks, because if the balloon breaks and the gas escapes into the vasculature, the highly compressible gas will allow the patient's blood pressure to drop too far thus rendering the circulation ineffective causing the death of the patient. Saline is also used because it is most similar to the fluid throughout the body and consequently creates little if any imbalance when introduced to the body. In view of this extreme commonality and the teachings of Fettel, it would have been obvious to use saline as taught by Fettel to inflate the balloon of Hermann particularly during intravascular procedures in order to prevent the entry of a gas into the vascular system.

*Allowable Subject Matter*

7. Claim 101 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The prior art does not teach that the sealing material is a self-sealing gel-like material, but rather a foam.

***Response to Arguments***

8. Applicant's arguments filed 12 March 2001 have been fully considered but they are not persuasive.

Again, the examiner takes the position that Hermann DOES teach that the sealing material does not readily form a passageway (i.e. lumen).

***Contacts***


Any inquiry concerning this communication should be directed to Jeremy Thissell at (703) 305-5261, or to Supervisory Patent Examiner Richard Seidel (703) 308-5115.

Jeremy Thissell

Patent Examiner

JT

April 19, 2001



RICHARD K. SEIDEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700